



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,021	10/28/2003	Henry Rosenthal	116364	3701

25944 7590 01/24/2005

OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER
----------

LUONG, VINH

ART UNIT	PAPER NUMBER
----------	--------------

3682

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

# Office Action Summary

Application No.

10/694,021

Applicant(s)

ROSENTHAL, HENRY

Examiner

Vinh T Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 and 03 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.


## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Vinh T. Luong  
Primary Examiner

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment.

1. The Amendment filed on November 3, 2004 has been entered.
2. Applicant's election with traverse of the species of Figs. 1-3 in the reply filed on May 20, 2004 is acknowledged. The traversal is on the ground(s) that no basis therefore has been set forth in the *written* record. This is not found persuasive because, pursuant to *telephone* restriction practice set forth in MPEP 812.01, the Examiner was not required to set forth the basis for the restriction in the *written* record *prior* to telephone the Applicant's attorney or agent of record to request an oral election on May 14, 2004. The Examiner was only required to set forth the basis for restriction *orally* by telephone on May 14, 2004. The basis in written record is provided in the Office action following Applicant's oral election as seen in paragraph 1 of this Office action. The requirement is deemed proper and is therefore made FINAL.
3. The drawings were received on November 3, 2004. These drawings are unaccepted by the Examiner because the corrected Fig. 1 and new Figs. 5-8 introduce new matter for the reasons, among other things, listed below:

(a) the new referential numeral 11 that indicates the inner layer of the body 10 as now shown in corrected Fig. 1 introduces new matter. See Attachment. Applicant's original disclosure does not disclose that the inner layer is extended to and contacted with the flange 14. In other words, the concept that the inner layer is extended to and contacted with the flange 14 is not conveyed in the original disclosure, *i.e.*, new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973);

(b) Applicant's original disclosure does not disclose that the inner layer, the flange 14, and the end wall 12 are formed as one piece as now shown in corrected Fig. 1. In fact, the description "[a] firmer less flexible grade is used to form a base or inner layer of the body 10,

Art Unit: 3682

as well as the end wall 12 and the flange 14” on page 4 of the original specification implies that the inner layer, the end wall 12, and the flange 14 are formed as separate pieces and connected together. In other words, the concept that the inner layer, the flange 14, and the end wall 12 are formed as one piece is not conveyed in the original disclosure, *i.e.*, new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973);

(c) the thickness of the inner layer (Att.) in comparison to the thickness of the outer layer as now shown in new Figs. 7 and 8 introduces new matter. The original disclosure does not describe the thickness of the inner layer in comparison to the thickness of the outer layer. Therefore, the original disclosure implies that the thickness of the inner layer may be equal, greater, or less than the thickness of the outer layer. The specific showing of the thickness of the inner layer relative to the thickness of the outer layer within a full spectrum of possible thicknesses is considered under the present disclosure to be new matter. *Cf.*, *In re Smith*, 173 USPQ 679 (CCPA 1972) and *Ex parte George*, 230 USPQ 575, 578 (BPAI 1986); and

(d) the arcuate portion of the outer surface of the outer layer that has projections as now shown in new Fig. 8 introduces new matter. The original disclosure does not describe that the arcuate portion that has projections is substantially greater than the other arcuate portion that does not have projection as now shown in Fig. 8. The original disclosure implies that the peripheral length or dimension of the arcuate portion that has projections may be equal, greater, or less than the peripheral length or dimension of the arcuate portion that does not have projection. The specific showing of the peripheral length or dimension of the arcuate portion that has projections relative to the peripheral length or dimension of the arcuate portion that does

not have projection within a full spectrum of possible lengths or dimensions is considered under the present disclosure to be new matter. *Cf., In re Smith, and Ex parte George, supra.*

4. The *original* drawings are objected to because each part of the invention, such as, the inner and outer layers in claims 4-9, and the base area in claim 1 should be designated by a referential numeral or character.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header as per 37 CFR 1.84(c) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the inner and outer layers in claims 4-9 must be shown *or the features canceled from the claims.*  
*No new matter should be entered.*

6. The amendment filed November 3, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the description of new Figs. 5-8 and the new referential numerals, such as, "11" to indicate the inner layer in corrected Fig. 1.

The Examiner respectfully submits that the original disclosure does not describe, among other things, that the inner layer is extended to and contacted with the flange 14. In other words, the concept that the inner layer is extended to and contacted with the flange 14 is not conveyed in the original disclosure, *i.e.*, new matter. *In re Anderson, supra*. See other new matter set forth in the disapproval for drawing correction in paragraph 3 above. Applicant is required to cancel the new matter in the reply to this Office Action.

7. Claims 1-9 are objected to because of the following informalities: the claims contain grammatical or typographical error, e.g., "in base area" in claim 1 should have been "in a base area." Appropriate correction is required.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 4-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention.

Claims 4-9 call for the inner and outer layers of different formulations of flexible,

Art Unit: 3682

resilient material. However, the *original* drawings do not show the inner and outer layers. *At the time the application was filed*, it was unclear as to how Applicant made/used the inner and outer layers and attached them together to form the claimed hand grip.

10. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury (US Des. 284,259).

Regarding claim 1, Oury teaches a hand grip (Figs. 1-5) adapted for non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising: a hollow cylindrical body having a first, open end; an opposing, second end; and an annular flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed thereover, said projections progressively in a base area (Figs. 4 and 5) and *increasing* in height from adjacent the flange to adjacent the second end.

Oury teaches the invention substantially as claimed. However, Oury's projections progressively *increasing instead of decreasing* in height from adjacent the flange to adjacent the second end.

It is common knowledge in the art at the time the invention was made to decrease instead of to increase the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the hand grip. The reversal/rearrangement of the height of Oury's projections would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) citing *In re Gal*, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992). See also *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 45

Art Unit: 3682

USPQ2d 1977 (Fed. Cir. 1998) and legal precedents cited for reversal, duplication, or rearrangement of parts in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to decrease instead of to increase the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the hand grip as taught or suggested by common knowledge in the art.

Regarding claim 2, Oury teaches the invention substantially as claimed. However, Oury does not teach the external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end.

It is common knowledge in the art at the time the invention was made to form the external diameter of Oury's cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip. The size or dimension of the external diameter of Oury's cylindrical body would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. See *In re Chu, supra* and legal precedents for changes in size/proportion in MPEP 2144.04.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the external diameter of Oury's cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip as taught or suggested by common knowledge in the art.

Regarding claim 3, Oury's second end is closed by an end wall as shown in Fig. 2.



Art Unit: 3682

11. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury in view of admitted prior art.

Regarding claims 4 and 7, Oury teaches the invention substantially as claimed. However, Oury does not teach the cylindrical body being formed from an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer.

Admitted prior art described in "Background Art" on pages 1 and 2 of applicant's specification teaches to form the cylindrical body of an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer in order to reduce potential for slippage by the rider's hand.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cylindrical body of an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer in order to reduce potential for slippage by the rider's hand as taught or suggested by admitted prior art.

12. Claims 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oury in view of Jannard et al. (US Patent No. 4,416,166).

Regarding claims 4 and 7, Oury teaches the invention substantially as claimed. However, Oury does not teach the cylindrical body being formed from an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer.

Art Unit: 3682

Jannard teaches to form the cylindrical body of an inner layer 11 and an outer layer 13 of different formulations of flexible, resilient material, in which respect the outer layer 13 is of greater flexibility than the inner layer 11 in order to provide better gripping for rider's hand. See Jannard's Summary of the Invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Oury's cylindrical body of an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer in order to provide better gripping for rider's hand as taught or suggested by Jannard.

Regarding claims 5 and 8, Jannard teaches the annular flange 11d and the closed end wall 11b formed of the same formulation of material as the inner layer 11 of the cylindrical body in order to provide better gripping for rider's hand.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Oury's annular flange and closed end wall formed of the same formulation of material as the inner layer of the cylindrical body in order to provide better gripping for rider's hand as taught or suggested by Jannard.

13. Claims 6 and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Art Unit: 3682

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bartkowicz (inner and outer layers 16 and 18), Yates (inner and outer layers 54 and 62), and Kuipers et al. (inner and outer layers 16 and 18).

16. Applicant's arguments filed November 3, 2004 have been fully considered but they are not persuasive.

### **Personal Interview, Election/Restriction, and Drawings**

Applicant states “[s]upport for new Figs. 5 and 6 is provided in original Figs. 1-4, page 2, lines 15-18; page 2, lines 1-2; and page 4, lines 14-19. Support for new Figs. 7 and 8 is provided in original Figs. 1-4; page 3, lines 4-9; page 4, lines 7-12 and original claims 4-19. Thus, Figs. 5-8 do not contain new matter.”

Contrary to Applicant's remarks, the quoted portion in the original disclosure does not provide support, e.g., the thickness of the inner layer relative to the thickness of the outer layer as now shown in new Figs. 7 and 8. Therefore, new Figs. 5-8 contain new matter as explained in paragraph 3 above.

### **Specification**

Applicant argues that “[s]upport for the amendments to the Specification may be found in the specification as cited in the discussion in the Drawings section above. Applicant requests the objection to the disclosure be withdrawn.”

However, note that support for the amendments to the Specification may not be found in the specification as cited in the discussion in the drawing correction disapproval above. Applicant's request to withdraw the objection to the disclosure is respectfully denied.

**35 USC § 112, First Paragraph**

Applicant contends that the amended drawings including new Figs. 7 and 8 show the inner and outer layers. However, the corrected drawings introduce new matter as explained above. *In re Smith* and *Ex parte George, supra*. To the extent that Applicants have complied with the Examiner's objection to the original drawings by corrected Fig. 1 and adding new Figs. 5-8 by submission of the amendment, the Examiner respectfully submits that the claimed feature in claims 4-9 required under 37 CFR 1.83 should have been shown *on the filing date*. The Applicant is respectfully advised that Section 608.01(h) of MPEP states:

If the best mode contemplated by the inventor *at the time of filing the application* is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. (Emphasis added).

Applicant further contends that "as such a method is not recited in the pending claims, there is no basis for which to object to the claims for this reason under 35 U.S.C. § 112, first paragraph. Thus, Applicant respectfully requests the rejection of claims 4-9 under 35 U.S.C. § 112, first paragraph, be withdrawn."

Note that 35 U.S.C. § 112, first paragraph, sets forth:

The specification shall contain *a written description of the invention*, and of the manner and process of making and using it, *in such full, clear, concise, and exact terms* as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention. (Emphasis added).

In the instant case, even though Applicant does not claim a method of making the hand grip, however, Applicant claims an apparatus, *i.e.*, the hand grip. Therefore, Applicant is required to provide a written description of the claimed hand grip as recited in claims 4-9 such

Art Unit: 3682

that any person skilled in the art to which it pertains, or with which it is most nearly connected makes and uses the same. Applicant's disclosure fails to describe in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected makes and uses the claimed hand grip in claims 4-9. Thus, Applicant's request to withdraw the rejection of claims 4-9 under 35 U.S.C. § 112, first paragraph, is respectfully denied.

### 35 USC §§ 102 & 103

#### **Larson et al.**

The rejections under 35 USC §§ 102 & 103 based on Larson et al. are withdrawn. Applicant's remarks are deemed to be moot.

#### **Oury**

At the outset, Applicant contends:

Applicant submits that "it is never appropriate to rely totally on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." See MPEP § 2144.03 citing *In re Zurko*, 258 F.3d at 1385, 59 USPQ 2d at 1697. *As the Office Action fails to provide evidentiary support for such common knowledge, Applicant submits that such a rejection is improper.* (Emphasis added).

The Examiner respectfully submits that the cited reference such as Livingston (US Patent No. D461,390 S) shows that the projections that decrease in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body is well known. In addition, Figs. 2 and 3 of Downey (US Patent No. 5,261,665) also show that the projections 20 that decrease in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body is well known. See also the height of the projection 21, 21b in Fig. 1

Art Unit: 3682

of Decker et al. (US Patent No. 4,941,232). Livingston, Downey, or Decker is an example of evidentiary support for such common knowledge.

Second, Applicant avers:

Applicant submits that as Oury merely discloses ornamentation on the cycle handle grip, that no function of such ornamentation can or may be, claimed. Rather, by definition, a design application cannot claim a function, but rather is merely for ornamentation.

Furthermore, the decrease in height of the projections from adjacent the flange to adjacent the second end is not merely a design choice as such a decrease in height provides the external taper to the body as recited in the rejected claims. Thus, increasing the height of the projections, as in Oury actually "teaches away" from the claimed subject matter.

The Examiner respectfully submits that Applicant fails to cite any legal authority that prohibits the use of a design patent to reject the claim(s) in an utility patent application. Indeed, Applicant's contention is transparently in direct conflict with MPEP § 2125 where MPEP clearly states: "[t]he origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents." It is well settled that "things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification." *In re Mraz*, 173 USPQ 25 (CCPA 1972). See also *In re Meng*, 181 USPQ 94, 97 (CCPA 1974).

Applicant disagrees with the Examiner's finding that Oury does not teach away from the claimed invention. Our reviewing court in *In re Fulton*, 73 USPQ2d 1141, (Fed. Cir. 12/2/04) quoted language from *In re Gurley* that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the

Art Unit: 3682

applicant.” 27 F.3d at 553. Accordingly, mere disclosure of alternative designs such as to progressively increase instead of decrease in height of the projections of prior art Oury does not teach away, especially, when the function of the projections to provide frictional gripping to the hand of the user is not changed. *In re Chu, supra*.

Third, Applicant asserts:

Furthermore, as clearly provided in the specification "by making the region adjacent the flange 14 somewhat thicker, particularly making this extra thickness from the soft rubber compound, extra cushioning on the rider's hand is provided in exactly the region of greatest pressure and greatest wear, i.e., below the arch formed by thumb and forefinger. Also because there is more material, this region does not wear down, split and fail as quickly as hitherto in the case of substantially constant external diameter grips." Thus, the arrangement of the projections as recited in the claims is not merely design choice, but provides the structure necessary to overcome the deficiencies of known motorcycle grips.

However, Applicant's remarks merely state an intended use that is subjectively dependent upon the mode of gripping of the hand grip of the user. If the user has the habit to hold or squeeze the area adjacent to the flange 14 of Applicant's hand grip, Applicant's statement may be true. But, if the user has, e.g., a small size hand and frequently holds or squeezes the area adjacent to the end wall 12 of Applicant's hand grip, the result would be reversed. In other words, if the user has the habit to grip the hand grip at the area adjacent to its end wall, Oury's hand grip is superior than Applicant's handgrip because the extra thickness of projections at the end region does not wear down, split and fail as hitherto in the case of substantially constant external diameter grips. Thus, the arrangement of the projections as recited in the claims is not

Art Unit: 3682

only a mere design choice, but also fails to provide the structure necessary to overcome the deficiencies of known motorcycle grips.

With respect to claim 2, Applicant insists:

However, the Office Action again alleges that it is "common knowledge" to form the external diameter as recited in claim 2. However, as stated above, it is never appropriate to rely solely on common knowledge in the art without evidentiary support on the record. Furthermore, to imbue one of ordinary skill in the art with knowledge of the invention when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome where in that which only the inventor taught is used against its teacher. *W. L. Gore and Associates v. Garlock, Inc.*, 721 F.2 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

As set forth above, the art of record such as Livingston, Downey, or Decker is the evidentiary support for such common knowledge. More important, the CAFC in *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 69 USPQ2d 1641 (Fed. Cir. 2004) reiterated that it has long been the law that the motivation to combine needs not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 [21 USPQ2d 1941] (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 [5 USPQ2d 1596] (Fed. Cir. 1988)). The motivation to combine can be located either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 [64 USPQ2d 1801] (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 [43 USPQ2d 1481] (Fed. Cir. 1997). Particularly, with respect to Applicant's hindsight arguments, the CAFC in *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC 2004) stated:



While this court indeed warns against employing hindsight, its counsel is just that – a warning. *That warning does not provide a rule of law that an express, written motivation to combine must appear in prior art references before a finding of obviousness.* Stated differently, this court has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved. See *Pro-Mold*, 75 F.3d at 1573; *Display Techs., Inc. v. Paul Flum Ideas, Inc.*, 282 F.3d 1340, 1346-47 (Fed. Cir. 2002); *In re Huang*, 100 F.3d 135, 139 n.5 [40 USPQ2d 1685] (Fed. Cir. 1996). *This form of motivation to combine evidence is particularly relevant with simpler mechanical technologies.* (Emphasis added).

In the instant case, the hand grip is plainly among simpler mechanical technologies. On the other hand, the nature of Applicant's problem to be solved is to prevent the wear and tear of the hand grip when the user has the habit of holding the grip at the area adjacent to the flange of the grip. This problem is just opposite to the problem of Oury, *i.e.*, to prevent the wear and tear of the hand grip when the user has the habit of holding the grip at the area adjacent to end of the grip. In other words, both Applicant and Oury apply the same solution to make the area of the grip whereat the user frequently holds or squeezes to be thicker. Hindsight is eliminated in the instant case because both Applicant and Oury are not only in the same field of endeavor (hand grip) but also solve the same problem in substantially the same way. See *In re Fulton, supra*.

With respect to claims 4-7 that are rejected under 35 U.S.C. § 103(a) as unpatentable over Oury in view of Applicant's admitted prior art. The rejection is respectfully maintained. The Examiner asserts that claims 4 and 7 are not allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Additionally, as Applicant's admitted prior art does overcome the deficiencies of Oury discussed above because admitted prior art teaches, *inter alia*, the inner and outer layers, Applicant's

Art Unit: 3682

request to withdraw the rejection of claims 4 and 7 under 35 U.S.C. § 103(a) is respectfully denied.

Similarly, the Examiner asserts that dependent claims 4, 5, 7 and 8 are not allowable for at least their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Additionally, as Jannard does overcome the deficiencies of Oury because Jannard teaches, *e.g.*, the inner and outer layers. Applicant's request to withdraw the rejection of claims 4, 5, 7 and 8 under 35 U.S.C. j103(a) is respectfully denied.

With respect to claims 6 and 9, the Examiner agrees to withdraw the previous rejection. Applicant's arguments regarding Oury, Jannard, and Downey are deemed to be moot.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Tuesday - Friday.

Art Unit: 3682

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

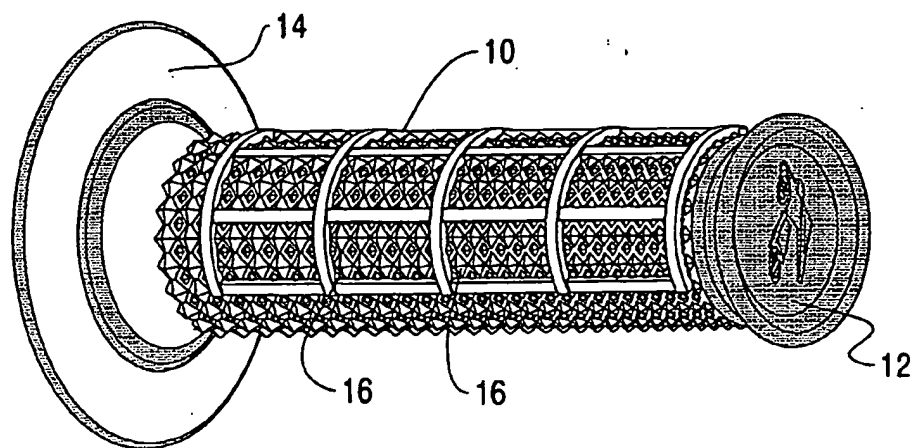
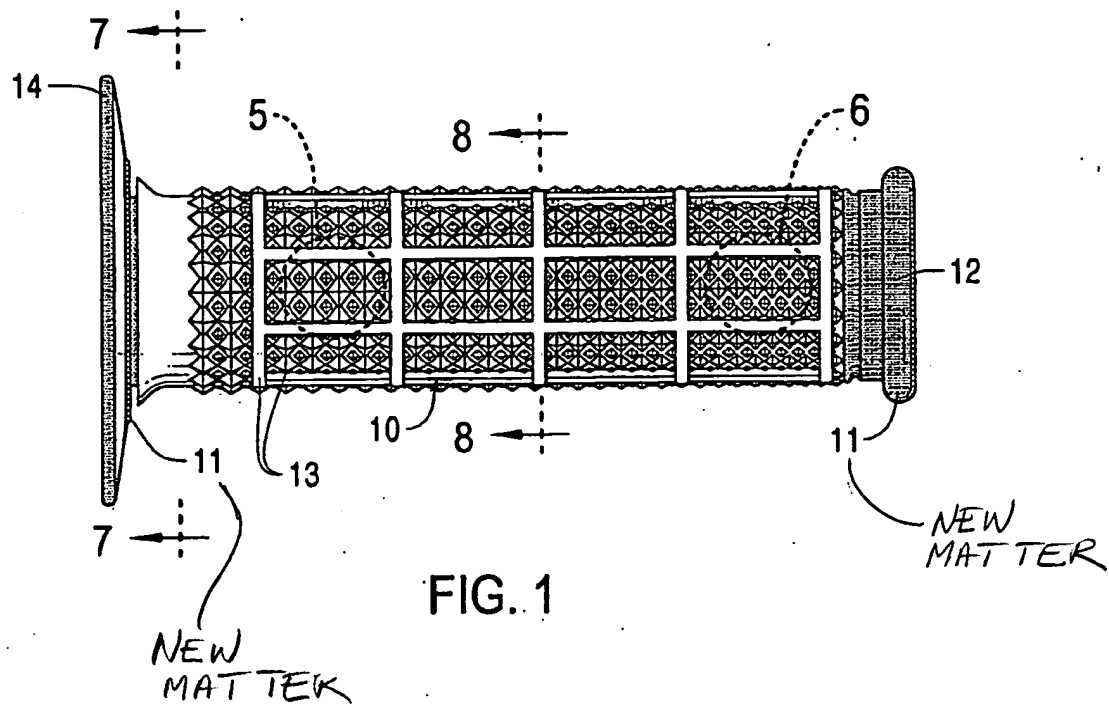
Luong

January 21, 2005



Vinh T. Luong  
Primary Examiner

# **ATTACHMENT**



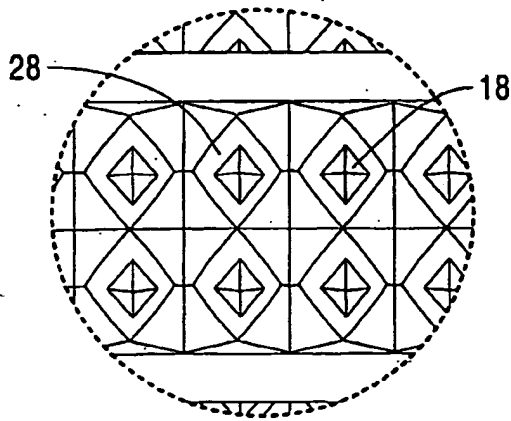


FIG. 5

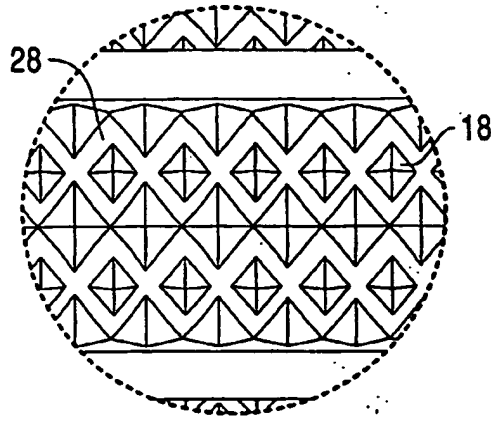


FIG. 6

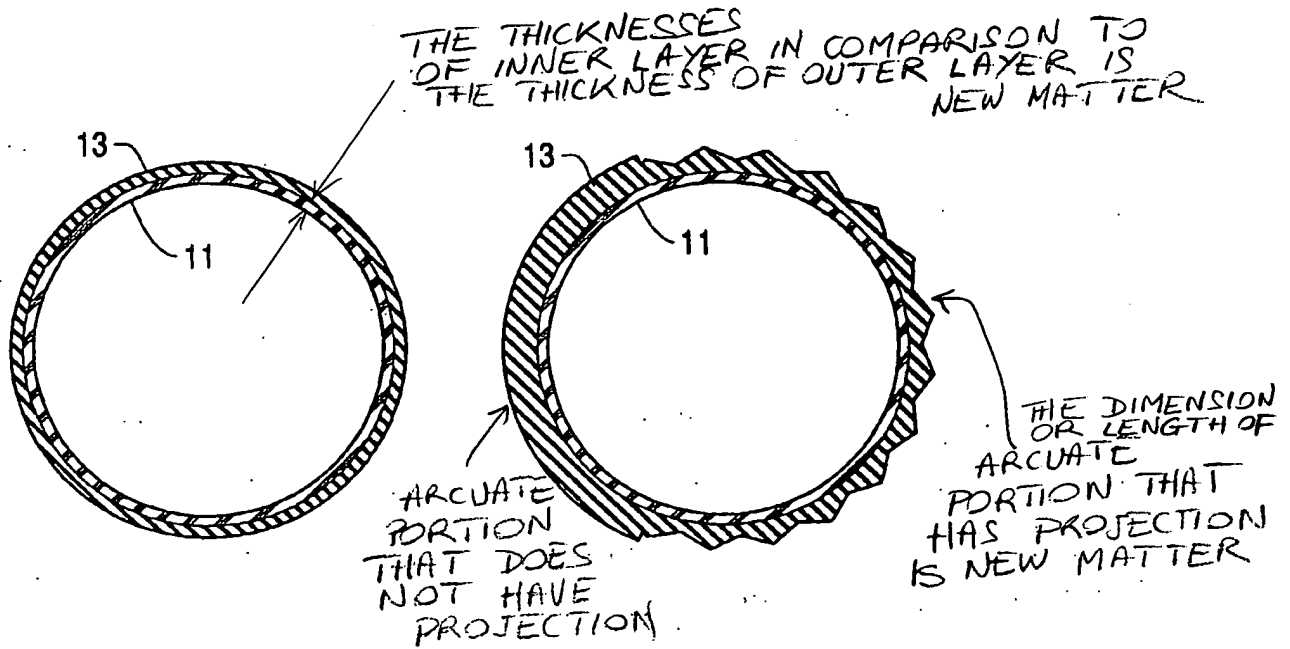


FIG. 7

FIG. 8